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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,964	12/14/2001	Heidi Riedel	Beiersdorf 755-KGB	7321
27384	7590	09/19/2005	EXAMINER	
NORRIS, MCLAUGHLIN & MARCUS, PA 875 THIRD STREET 18TH FLOOR NEW YORK, NY 10022			JIANG, SHAOJIA A	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 09/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/016,964

Applicant(s)

RIEDEL ET AL

Examiner

Shaojia A. Jiang

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-13, 15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-13, 15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to Applicant's amendment and response filed on July 12, 2005 wherein claims 1-6, 8-13, and 15-16 have been amended and claim 17 is newly submitted. Claim 7 and 14 are cancelled previously.

Currently, claims 1-6, 8-13, and 15-16 are pending in this application.

Claims 1-6, 8-13, and 15-16 are examined on the merits herein.

The following is new rejection(s) necessitated by Applicant's amendment filed on July 12, 2005.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

New Claim 16 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant's amendment submitted July 12, 2005 with respect to new claim 16 has been fully considered but is deemed to insert new matter into the claims since the specification as originally filed does not provide support for "said emulsion comprising less than 5% by weight of the emulsion of any emulsifier other than A, B or C". The

original specification and claim 10 merely discloses "[t]he preparation as claimed in claim 8, wherein the total amount of the further emulsifier is chosen to be less than 5% by weight based on the total weight of the formulation". **Nowhere** can the recitation in claim 16 be found in the specification as originally filed.

Consequently, there is nothing within the instant specification which would lead the artisan in the field to believe that Applicant was in possession of the invention as it is now claimed. See *Vas-Cath Inc. v. Mahurkar*, 19 USPQ 2d 1111, CAFC 1991, see also *In re Winkhaus*, 188 USPQ 129, CCPA 1975.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 11, 13, and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bellon et al. (FR 2,789,397 with English translation of record) for the same reason of record stated in the Office Action dated January 12, 2005.

Bellon et al. exemplify a facial foam composition or preparation comprising 22% PEG-100 stearate glyceryl stearate which is a polyethoxylated fatty acid ester in the instant claim 1 (I)-B: stearate having a chain 18 carbons and 100 of ethoxylation;

12% stearic acid which is a fatty acid in the instant claim 1 (I)-A: stearic acid having a chain 18 carbons;

6% octyldodecanol, which is a fatty alcohol in the instant claim 1 (I)-C having a chain 20 carbons; nitrogen added to the composition in 70% by volume which is one gas in claim 1 (II). See Example 1 and Table 1 (at page 10-11 and 16 of the English translation). The claims therein recite a method of caring for skin comprising applying the composition to the skin. Bellon et al. disclose that the lipid phase in Example 1 which is phase A, is 40.7% of total weight which is obtained from the sum total of phase A (see page 11).

Bellon et al. do not expressly disclose that the amount of PEG-100 stearate glyceryl stearate, a polyethoxylated fatty acid ester in the instant claim 1 (I)-B, is 2-20%. Bellon et al. do not expressly disclose a ratio of A:B:C of 1:1:1.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to optimize the amount of PEG-100 stearate glyceryl stearate, a polyethoxylated fatty acid ester to 20% from 22%, and a ratio of A:B:C of 1:1:1.

One having ordinary skill in the art at the time the invention was made would have been motivated to optimize the amount of PEG-100 stearate glyceryl stearate, a polyethoxylated fatty acid ester to 20% from 22%, since 22% of PEG-100 stearate glyceryl stearate may read about 20% or is very close to 20%. Moreover, the optimization of the ratio of A:B:C based on the prior art teachings, is considered well within conventional skills in pharmaceutical science, involving merely routine skill in the art.

It has been held that it is within the skill in the art to select optimal parameters, such as amounts of ingredients, in a composition in order to achieve a beneficial effect. See *In re Boesch*, 205 USPQ 215 (CCPA 1980).

Further, placing a known cosmetic composition or preparation in a package is deemed obvious since it is well within the knowledge and conventional skills in the art.

Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bellon et al. in view of Synder (4,708,813) for the same reason of record stated in the Office Action dated January 12, 2005.

Bellon et al. is applied as discussed above. The reference lacks a hydrophilic emulsifier.

Synder teaches a nonlathering cleansing mousse with skin conditioning benefits. Sorbitan monostearate is taught as a surfactant that provides skin cleansing benefits and imparts a uniform dispersion of emollient and other ingredients in the composition. Surfactants are disclosed as comprising 1.5-15% of the composition. See abstract; Col. 4, line 26-Col. 5, line 24.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the sorbitan monostearate of Synder to the composition of Bellone et al. because of the expectation of achieving a composition with greater skin cleansing benefits and which imparts uniformity to the emulsion.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bellone et al. as applied to claims 1-6, 11, 13 and 15 above, in view of Saint-Leger et al. (5,939,077) for the same reason of record stated in the Office Action dated January 12, 2005.

Bellone et al. is applied as discussed above. The reference lacks carbon dioxide. Saint-Leger et al. teach cosmetic compositions. Carbon dioxide and nitrogen are taught as interchangeable gases that are used in producing cosmetic foams. See Col. 4, lines 7-15.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the nitrogen of Bellone et al. for carbon dioxide because Saint-Leger et al. teach carbon dioxide and nitrogen as equivalent gases for use in producing cosmetic foams.

Response to Argument

Applicant's arguments filed July 12, 2005 with respect to the rejections made under 35 U.S.C. 103(a) of record in the previous Office Action January 12, 2005 have been fully considered but are not deemed persuasive as to the nonobviousness of the claimed invention over the prior art as further discussed below.

Applicant asserts that the Examiner's continued reliance on *In re Aller* 105 USPQ 233 (CCPA 1955). Contrary to Applicant's assertion, the examiner cites *In re Boesch*, 205 USPQ 215 (CCPA 1980), not *In re Aller*.

Applicant again asserts that Bellon cannot render the present claims *prima facie* obvious. Applicant further asserts that "Bellon does not teach or suggest anywhere the

choice and quantity of emulsifiers to be a result-effective variable effecting long-term stability of the preparation. Contrary to Applicant assertion, Bellone et al. disclose a substantially similar emulsifier system to the one claimed herein having all three essential ingredients wherein B and C are in the same amounts as claimed herein, except the amount of PEG-100 stearate glyceryl stearate is 22% not 20%. However, one of ordinary skill in the art would clearly recognize that 22% of PEG-100 stearate glyceryl stearate may read about 20% or is very close to 20%.

Regarding the hydrophilic emulsifiers, Synder has been cited for the teachings that sorbitan monostearate is a known emulsifier as a surfactant that provides skin cleansing benefits and imparts a uniform dispersion of emollient and other ingredients in the composition. Sorbitan monostearate is known to be used in many known skin cleansing compositions or products. Surfactants are disclosed by Synder as comprising 1.5-15% of the composition in a nonlathering cleansing mousse with skin conditioning benefits. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add the sorbitan monostearate of Synder to the composition of Bellone et al. because of the expectation of achieving a composition with greater skin cleansing benefits and which imparts uniformity to the emulsion.

It must be recognized that any judgment on obviousness takes into account knowledge which was generally available and within the level of ordinary skill at the time the claimed invention was made. Knowledge of those skilled in art and nature of problem solved provided motivation and made obvious a combination of elements --

Princeton Biochemicals, Inc. v. Beckman Coulter, Inc. 04-1493 -- On June 9, 2005,

recently the Federal Circuit upheld a finding of obviousness of Princeton's capillary electrophoresis device, used to separate proteins and other matter. This court upheld that motivation to combine the elements came from the knowledge of those skilled in the art and the nature of the problem solved by the invention.

In this case, Bellon et al. in view of Synder has clearly provided the knowledge which was generally available and within the level of ordinary skill at the time the claimed invention was made and nature of problem solved.

Further, Applicant's assertion regarding the new claim 16 that "Bellon does not teach or suggest the prepackaged foams as required by claim 16". Note that "prepackaged foams" is deemed an inherent property of a composition. It has been well settled that recitation of an inherent property of a composition will not further limit claims drawn to a composition, so long as the prior art discloses the same composition comprising the same ingredients in an amount as the instantly claimed.

Moreover, note that the recitation "said emulsion comprising less than 5% weight of the emulsion of any emulsifier other than A, B or C" in claim 16 reads on 0% weight of the emulsion of any emulsifier other than A, B or C.

Thus, the claimed invention is clearly obvious in view of the cited prior art.

Furthermore, the record contains no clear and convincing evidence of nonobviousness or unexpected results for the combination method herein over the prior art. In this regard, it is noted that the specification provides no side-by-side comparison with the closest prior art in support of nonobviousness for the instant claimed invention over the prior art.

Note that arguments of counsel cannot take the place of factually supported objective evidence. See, e.g., *In re Huang*, 100 F.3d 135, 139-40, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996); *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984). The burden is shifted to Applicant to show factually supported objective evidence to rebut the prima facie case of obviousness over the prior art.

In view of the rejections to the pending claims set forth above, no claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 1617

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (571)272-0627. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



S. Anna Jiang, Ph.D.
Primary Examiner
Art Unit 1617
September 14, 2005